

Appl. No. 10/643,500
Amdt. dated December 22, 2006
Reply to O.A. dated September 27, 2006

REMARKS/ARGUMENTS

STATUS OF THE CLAIMS. Claims 1-21 were originally filed in the above-captioned case. Of those, claims 1, 2, 4-8, 13, 14, and 17-21 are amended herein. Additionally, claims 22-24 are new claims presented herein. Accordingly, claims 1-24 are now pending in this case.

INDEFINITENESS REJECTION. Claims 1-21 stand rejected under Section 112, ¶2, as allegedly being indefinite. According to the Office action, these rejections are due to inclusion of the terms "intermediate" and "aloe vera gel 200%".

Applicants respectfully submit that the claims as read in the context of the specification by one of ordinary skill in the art are by no means indefinite. Nonetheless, in the interest of moving prosecution along and applicants' view that these terms can be amended to reflect terminology disclosed in the specification without diminishing scope, these terms are hereby amended, as follows: "intermediate" is now stated as --intermediate constituent-- and "aloe vera gel 200%" is now stated as --aloe vera gel--. These changes appear in claims 1, 4, 14, 17, 18, 19 with respect to the intermediate constituent and in claims 2 and 19 with respect to aloe vera gel. Support for these changes can be found in the specification at, for example, page 7, where "intermediate" is included in a table as a "constituent" of the exemplified formulation according to the present invention. Further support can be found at, for example, page 4, where "aloe vera gel 200%" is described as "...an additional moisturizer." The 200% term modifying the aloe vera gel merely relates to one aloe preparation, having a concentration of aloe relative. See attachment of listing of various commercial providers of aloe preparations; copied from <http://www.chembuyersguide.com/search.cfm?searchMode=EXE>, which discloses a number of preparations of aloe vera used as a moisturizer. Accordingly, the recital at page 4 of the specification that a preferred embodiment of the present invention includes "aloe vera gel 200%" as a moisturizer without stating or suggesting criticality of that form of that moisturizer should not limit the present invention to inclusion of aloe vera gel only as a 200% preparation. Instead, one of ordinary skill in the art, knowing that the aloe vera gel 200% will become diluted in the inventive composition, would understand that other aloe preparations having varying concentrations of the same leaf extract may also be employed for the same

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purpose. Other such preparations are certainly not precluded based on the writing in applicants' specification, which preparations are readily available, such as the commercial outlets listed in the attachment hereto.

For the foregoing reasons, the Section 112, ¶2 rejections are surmounted by the claims as amended and currently set.

AMENDMENTS. Certain amendments included herein relate to correcting: typographical and grammatical errors, as found in claims 1, 4, 7, 8, 13, 14, 17, 18, and 19; a lack of antecedent basis in claims 20 and 21; and removing unnecessary terms in claims 1, 2, and 6.

New claim 22 relates to the concentration of lactic acid in the composition that was previously included in claim 1.

New claim 23 relates to the proportion of diluent constituent that is the blend, which is supported in the specification at, for example, page 5.

New claim 24 relates to the proportion of the composition that is diluent, which is supported in the specification at, for example, page 5.

Based on support identified in the specification as understood in the context of knowledge of ordinarily skilled artisans, the simple correction of typographical and grammatical errors, and the removal of identified language, applicants respectfully submit that no new matter has been introduced by way of any of the above-noted amendments.

OBVIOUSNESS REJECTION. Claims 1-21 stand rejected as allegedly obvious over U.S. Patent 5,902,225 ("Monson") in view of E.P. 170 269 ("EP"). Applicants respectfully traverse this rejection.

Not only is Monson deficient in not disclosing lactic acid as a component of its composition, for any purpose, neither does Monson suggest any such inclusion. Moreover, the Monson composition does not result in the surprising quality of small bubbles upon dispensation. Monson and the desirability of smaller versus larger bubbles in a skin preparation product is discussed in applicants' specification. In a comparative assessment, applicants demonstrate a surprising increase in the beneficial characteristic of applicants' invention relating to bubble size. As noted by applicants, it is known in the art that "the size and numbers of bubbles produced [by a skin preparation composition] are important factors

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for use as a lubricant and humectant. The smaller the bubbles, the more surface area is present to hold water to the skin of a user and thus easier it is [to] shave." Specification at 6. FIGS. 1-8 of applicants' application are two sets of time-sequence photos of the Monson foaming composition (FIGS. 1-4 dispensed at 85 psig; FIGS. 5-8 dispensed at 40 psig). FIGS. 9-15 are two sets of photos of the composition of the present invention (FIGS. 9-12 dispensed 85 psig; FIGS. 13-15 dispensed at 40 psig). Each set of photos depict the respective compositions at 10 seconds, 20 seconds, 30 seconds, and 60 seconds after dispensing. Applicants' stated that the photos show that "a composition according to the present invention dispensed at 85 psig results in a greatly increased number of bubbles and a small bubble size both throughout the exposure time." Specification at 6. Applicants noted that the photos of the dispensed composition using 40 psig also showed the advantage of substantially smaller bubble sizes in their dispensed composition relative to the Monson composition.

Moreover, the Monson patent includes instruction that clearly leads the reader away from the composition taught by applicants. For example:

- The blend of bicarbonate and citric acid in Monson constitutes no more than 3.5% of Monson's diluent, as noted in Monson's examples. Monson at cols. 11-14. In contrast, applicants' blend constitutes over a 10-fold greater proportion of their diluent. Specification at 5.
- The proportion of diluent in the final composition taught by Monson ranges from 16% to 99.4%, as disclosed at column 7. All of Monson's examples present protocols where diluent constitutes a majority of the composition, i.e., between 66% and 80%. Monson at cols. 10-14. In contrast, applicants' composition is no more than 12% diluent. Specification at 5.

Therefore, not only is the carbon dioxide-forming blend of bicarbonate and acid substantially less in Monson's diluent relative to the blend included in applicants' diluent, but the blend in the final composition itself is significantly more dilute in Monson's than in applicants'.

Following Monson, the concentration of carbon dioxide-forming blend in the composition is

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of a range between about 0.5% and about 3.5%; and is exemplified to be between 2.3% and 2.8%. In contrast, the carbon dioxide-forming blend in applicants' final composition is greater than 3.8% through about 5%. In consequence of these significant differences and the surprising result relating to bubble characteristics, Monson is not even remotely an appropriate reference to support an obviousness rejection. Quite the contrary, Monson supports the nonobviousness of applicants' invention, and is shown as such in applicants' specification, as noted above.

The Office action states that Monson's deficiencies can be overcome when considered in combination with EP 170269 ("EP"). Applicants respectfully disagree. First of all, EP is not analogous art to applicants' invention, contrary to the view espoused in the Office action at page 4. The EP technology is part of the dermatological field, *i.e.*, treatments and products designed to have a medical effect on skin. The EP patent has a title that starts with the term "Medicated" and relates to compositions that include "at least one medicament selected from the group consisting of antiseborrheics, bactericides, anti-inflammatory agents and refrigerants." EP at 1 (Abstract) and repeated at 3-4. No non-medicating uses or compositions are set forth. In contrast, applicants' invention includes no medicament of any sort. The present application is entitled "Skin Preparation Composition"; it clearly describes a composition for a "shaving preparation." Specification at 8. These are distinctive, non-analogous areas of art that are not properly combined in a Section 103 rejection. Even if one were to stretch the definition of "analogous" art to include both a shaving cream and a salve, for example, the purposes of these two technologies as recited in the respective writings are NOT the same: EP's is for providing improved medical effect; applicants' is for providing a "flowable shaving cream type product rather than a gel...." EP at 14; Specification at 8.

Moreover, for the combination of elements found in separate references to support the rejection, there must be "reason, suggestion, or motivation to make that combination." *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996). The Office action contends that the disclosure of lactic acid in EP, directed at a medicated cosmetic, in combination with Monson renders applicants' invention obvious. However, the Office action's recital at pages 4-5 that the purposes of the technologies set forth by Monson, EP, and applicants is the same is, with respect, just plain wrong. As noted

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above, the EP patent reports an improved medical cosmetic, *i.e.*, a preparation that can cure or ameliorate a dermatological malady. In contrast, applicants' preparation is a better shaving cream, curing nothing.

Presuming that one of ordinary skill did have knowledge of EP, the description there of use of lactic acid as a "pH modifier" without more cannot present reason, suggestion, or motivation to one skilled in the art, let alone a routineer, to include this chemical for its moisturizing effect in a shaving cream prepared otherwise according to Monson. *See* EP at 8. Without identifying motivation or suggestion for the combination, such picking and choosing of components identified in different references is improper hindsight analysis under Section 103.

As noted above, of course, following Monson's protocols will lead one astray from applicants' invention in the first place. Citing EP provides no further instruction by which the routineer might arrive at applicants' invention. Accordingly, the cited art cannot support the obviousness rejection; therefore, applicants request that the Section 103 rejections be withdrawn.

Reconsideration and allowance of the foregoing claims, as amended, are respectfully requested.

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The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees, which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

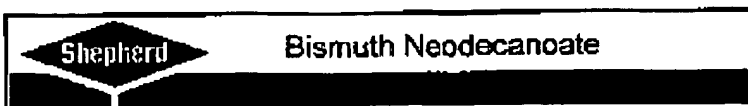
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December 22, 2006

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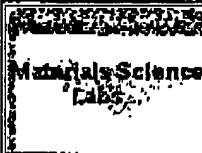
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